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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,586	10/31/2003	Ari Moskowitz	151P11200US01	1882
23322	7590	05/03/2005	EXAMINER	
<b>IPLM GROUP, P.A.</b> POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418				ROLLINS, ROSILAND STACIE
		ART UNIT		PAPER NUMBER
				3739

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/699,586	MOSKOWITZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rosiland S Rollins	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 04 February 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 04 February 2005 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Madsen (US 6761718).*** Madsen discloses an apparatus and method for making a hole of a first predetermined diameter in a dura of a patient comprising a catheter (2), a stylet (21) having a first end (23) adapted for insertion in the lumen and a second end. The apparatus also includes a means for applying electrical current to the stylet and the tip also has a hemispherical shape as illustrated in figure 4 adjacent to reference number (68).

***Response to Arguments***

Applicant's arguments filed 2/4/05 have been fully considered but they are not persuasive.

**The apparatus claims**

In response to applicant's argument that Madsen et al. is not for making a hole in the dura, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding the argument that the second end of the elongate body of the bipolar coagulator in Madsen et al. has no predetermined relationship with a first predetermined diameter of a hole to be made in the dura, the Madsen et al. device inherently includes a tip having a diameter having a predetermined relationship with the first predetermined diameter, particularly in view of the fact that the “predetermined relationship” has not been defined.

Regarding the argument that Madsen et al. disclose bipolar electrodes to cauterize a lateral area between the electrodes provided in contrast to the unipolar electrode containing a tip electrode, which cauterizes the dura contacting the tip of the stylet, the electrodes of Madsen et al. are located on the tip of the device (see figure 1b). These electrodes satisfy the requirements of the claims – “means for applying an electrical current to said tip of said stylet to cauterize said dura”.

#### **The method claims**

Applicant argues that Madsen et al. does not disclose a method for making a hole in the dura of a patient for insertion of a catheter. In column 1 line 58 – column 2 line 5, Madsen et al. establishes the method as claimed as being old and well known in the art.

Regarding the argument that the second end of the elongate body of the bipolar coagulator in Madsen et al. has no predetermined relationship with a first predetermined diameter of a hole to be made in the dura, the Madsen et al. device inherently includes a tip having a diameter having a predetermined relationship with the first predetermined diameter, particularly in view of the fact that the "predetermined relationship" has not been defined.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Rosiland Rollins*  
Rosiland S Rollins  
Primary Examiner  
Art Unit 3739

RR



Replacement Drawing  
Serial No.: 10/699,586 Confirmation No.: 1882

Approved  
5/1/05  
RE

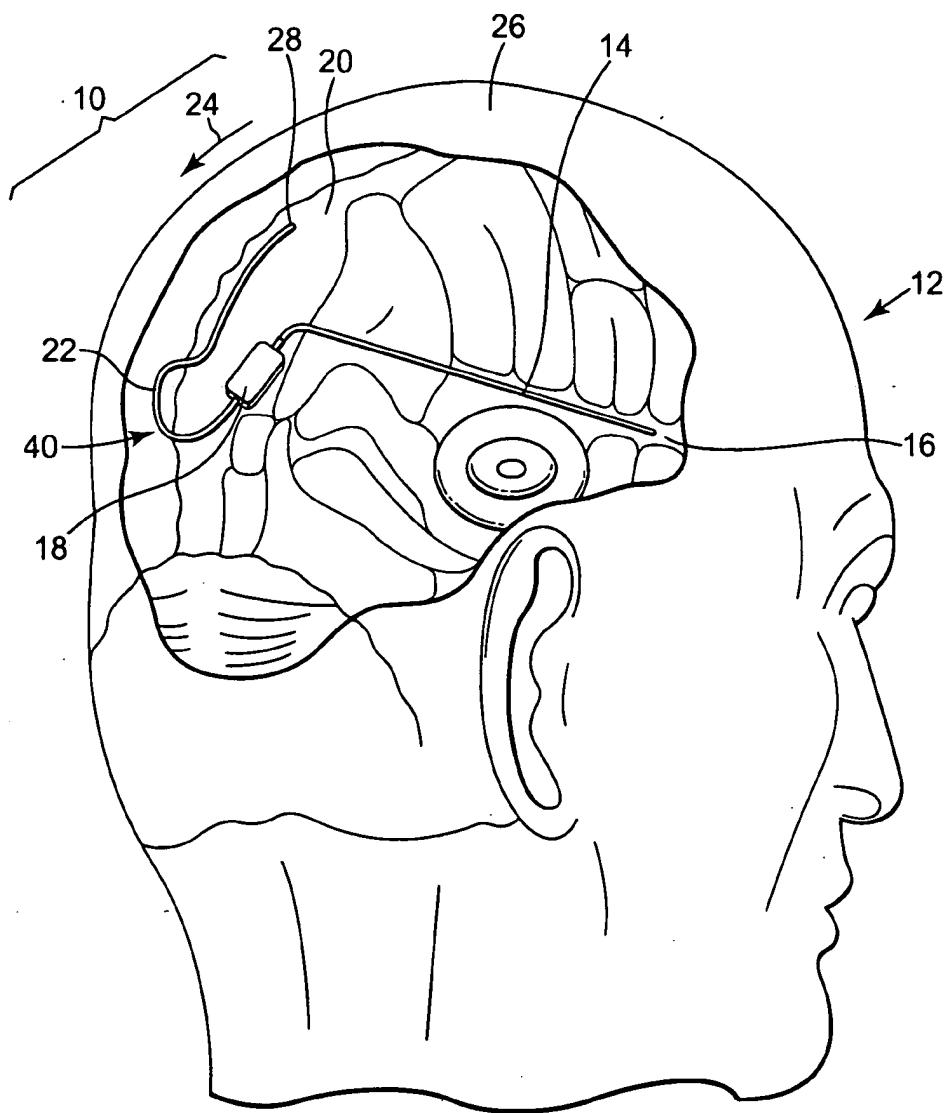


Fig. 1

Approved 5/15  
RR

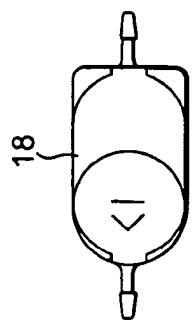


Fig. 3A

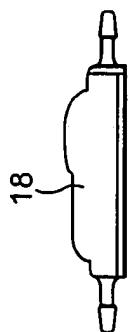


Fig. 3B

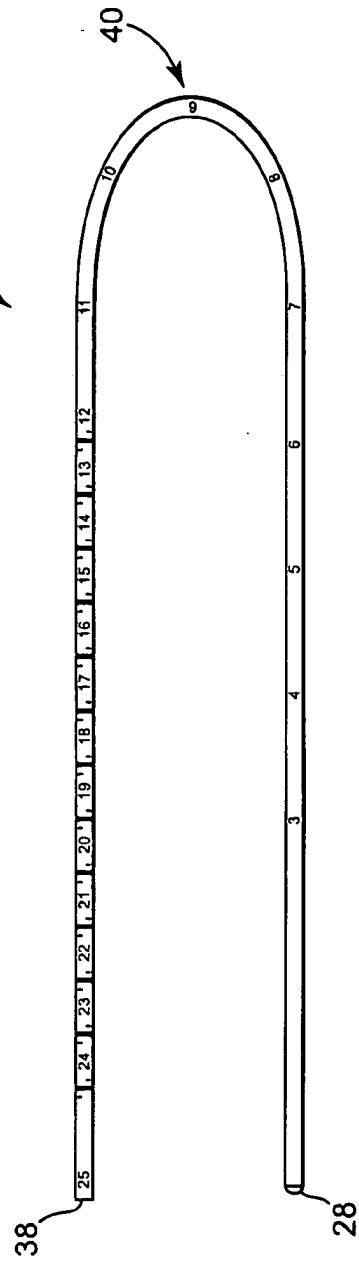


Fig. 4